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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,341	07/31/1998	MICHAEL DEADDIO	11021.0001	9998

7590

12/02/2003

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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/127,341

Applicant(s)

De Addio et al

Examiner

Fclten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/22/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-33 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

1. Receipt of the Request for Continued Examination (RCE) filed Oct 22, 2003 canceling claims 17-20 and adding claims 21-33. 21-33 are pending in the application and are presented to be examined upon their merits.

Claim Rejections - 35 USC 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The definition of the term processing in the specification as any and all operations that can be applied to a financial instrument and its events does not disclose how such operations are enabled by the invention to the representation. In other words, the specification gives no indication of how the representation(s) is/are being acted

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upon via the processor(s). For the sake of examination, however, the examiner will interpret processing to mean the manipulation of data within the computer system in such a way as to render a tangible result related to some aspect, characteristic or behavior of the financial instrument.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 21-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what is meant that representation is specified separately from said at least one processor.

Claim Rejections - 35 USC 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 21-24 and 27-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Marshall (US 5,675,746).

Re claim 21:

Marshall discloses a method for processing financial instruments comprising a representation (metaphors or cards) of the instrument and at least one processor (see modules) , wherein said at least one processor performs said processing by acting upon said representation , and wherein the representation is specified separately from at least one processor (see Marshall, col. 2, ll. 27+; col. 4, ll. 28+; and col. 15, ll. 17+; and col. 16, ll. 27-63).

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Re claim 22- 24:

Marshall discloses wherein the representation further comprises said instrument inputs, the relationships of said inputs with each other and how said relationships combine to produce a series of financial event streams (see Marshall, col. 2, ll. 27+; col. 4, ll. 28+).

Re claims 27 and 28:

Marshall discloses wherein processing is implemented via polymorphism (see Marshall, col. 2, ll. 27+; col. 4, ll. 28+; and col. 15, ll. 17+; and col. 16, ll. 27-63)

Re claim 29:

Marshall discloses wherein a plurality of processors may be utilized to provide alternative methods of performing a type of processing upon the instrument without changing the representation of the instrument (see Marshall, col. 2, ll. 27+; col. 4, ll. 28+).

Re claim 30 and 31:

Marshall discloses wherein said representation is composed from a set of primitives (see Marshall, col. 2, ll. 27+; col. 4, ll. 28+; and col. 15, ll. 17+; and col. 16, ll. 27-63).

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Re claim 32 and 33:

Marshall discloses a system and machine readable medium for storing a computer program comprising at least one digital computer, storage means and input-output peripheral means, adapted so as to perform the processing of financial instruments.

(see Marshall, col. 2, ll. 27+; col. 4, ll. 28+; and col. 15, ll. 17+; and col. 16, ll. 27-63).

Claim Rejections - 35 USC 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall.

Re claim 25 and 26:

Official Notice is taken of double dispatch because it would have been an obvious extension to the teaching of Marshall.

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Conclusion

10. A list of relevant prior art appears below not relied upon in this Office Action:

US Patent:

Graf et al (US 5,631,984) discloses a method and apparatus for separation static and dynamic portions of document images

Ikenoue et al (US 5,987,1270) discloses image forming apparatus and copy management system

Schoppers (US 5,392,382) discloses automated plan synthesizer and plan execution method

Passera et al (US 5,909,681) discloses computer system and computerized method for partitioning data for parallel processing

Graf et al (US 5,631,984) discloses method and apparatus for separating static and dynamic portions of document images

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiners supervisor ***Vincent Millin*** whose telephone number is (703) 308-1065.

12. Response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label Proposed or Draft.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to *[daniel.felten@uspto.gov]*.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.



DSF

November 06, 2003



VINCENT MILLIN
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